REMARKS

As a result of this amendment Claims 11, 14, 19-21 have been amended. Claims 11-17, 19-21 are now pending. No new matter has been added by way of amendment.

Objections

Claim 20 has been objected to under 37 CFR 1.75 (c).

Applicants believe the amendment to the claim address the multiple dependency issue raised by the Examiner on page 3 of the Office Action.

The Claim Rejections

Claims 11-14, 16-17, 19-21 have been rejected under 35 USC 112, second paragraph.

Applicants believe the amendments to the claims address the issues raised by the Examiner in paragraphs 1-6. Applicants also attach herewith at the end of this paper a clean set of claims as requested by the Examiner. Regarding paragraph 1, the "C1-4 alkoxy group" in claim 11 of the R2 definition is not extraneous and should be included in the R2 definition as is supported by the claims as originally filed. Regarding paragraph 4, the phrase "or with the reactive derivatives thereof" goes with the formula (V), this is supported by the claim as originally filed.

Withdrawal of the 35 USC 112, second paragraph rejection is therefore respectfully requested.

Claims 11-14, 16-17, 19-21 have again been rejected under 35 USC 112, first paragraph.

While not agreeing with the propriety of the rejection and solely to advance prosecution in the case, the present claims have been amended to a narrower scope for R_a . In addition to phenyl, pyridinyl which the Examiner has acknowledged is enabled, presently R_a also

covers pyrimidinyl, thiophenyl, oxazolyl and thiazolyl. Exemplifications are taught in the instant specification as follows: example 44: thiophenyl, example 45: oxazolyl, example 38: thiazolyl and examples 41-42 for pyrimidinyl. Applicants believe that the instant claims are enabled for the full scope of the claims and are therefore in compliance with 35 USC 112, first paragraph.

Withdrawal of the 35 USC 112, first paragraph rejection is therefore respectfully requested.

Certificate of Mailing Under 37 C.F.R. § 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to
Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Anthony P. Bottino
Reg. No. 41,629
6/29/2004
Dated

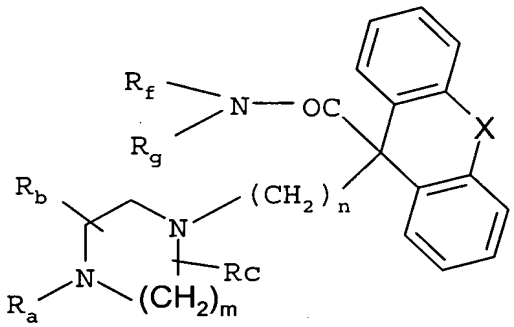
Respectfully submitted,

Anthony P. Bottino
Registration No. 41,629
Attorney for Applicants

BOEHRINGER INGELHEIM CORPORATION
Patent Department
900 Ridgebury Road/P.O. Box 368
Ridgefield, CT 06877
Telephone: (203) 791-6764
Facsimile: (203) 798-4408

CLEAN SET OF CLAIMS

11. A compound of the formula (I)



, (I)

wherein

n denotes the number 1, 2, 3, 4 or 5,

m denotes the number 2,

X denotes a carbon-carbon bond,

R_a denotes a phenyl group or a heteroaryl group chosen from pyridinyl, pyrimidinyl, thiophenyl, oxazolyl and thiazolyl each substituted by the groups R_1 and R_2, wherein

> R_1 denotes a hydrogen, fluorine, chlorine, a C_{1-3}-alkyl group wherein the hydrogen atoms of the alkyl are optionally wholly or partly replaced by fluorine atoms, a C_{1-4}-alkoxy group, a phenoxy, phenyl-C_{1-3}-alkoxy, nitro or amino, wherein the abovementioned phenyl of the phenoxy is optionally substituted by chlorine or methoxy, and

R_2 denotes a hydrogen, chlorine or C_{1-4}-alkoxy,

or R_a denotes a heteroaryl chosen from pyridinyl, pyrimidinyl, thiophenyl, oxazolyl and thiazolyl or phenyl group which is substituted in each case by a phenyl group,

R_b and R_c independently of one another denote a hydrogen atom or a C_{1-3}-alkyl group and

R_f denotes C_{1-6}-alkyl wherein the hydrogen atoms of the alkyl are optionally wholly or partly replaced by fluorine atoms, phenyl-C_{1-3}-alkyl wherein the phenyl is optionally substituted by fluorine or C_{1-3}-alkoxy,

R_g is hydrogen;
or
the enantiomeres, diastereomers or the salts thereof.

12. The compound according to claim 11, wherein

n denotes the number 3, 4 or 5.

13. The compound according to claim 11, wherein

R_b and R_c independently of one another denote a hydrogen atom or a methyl group.

14. The compound according to claim 11, wherein

n denotes the number 4,
m denotes the number 2.

15. A compound chosen from

9-[4-(4-biphenyl-3-yl-piperazin-1-yl)-butyl]-9H-fluorene-9-carboxylic acid-(2,2,2-trifluoroethyl)-amide and

9-[4-(4-biphenyl-4-yl-piperazin-1-yl)-butyl]-9H-fluorene-9-carboxylic acid-(2,2,2-trifluoroethyl)-amide

or the enantiomeres, diastereomers or the salts thereof.

16. A physiologically acceptable salt of the compound according to claim 11.

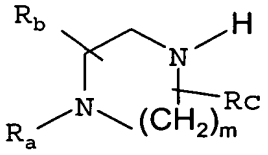
17. A pharmaceutical composition comprising a pharmaceutically effective amount of a compound according to claim 11 with one or more pharmaceutically acceptable inert carriers and/or diluents.

19. A method of treating a disease selected from hyperlipidaemias, atherosclerosis, diabetes mellitus, adiposity and pancreatitis, said method comprising administering to a patient in need thereof a pharmaceutically effective amount of a compound according to claim 11.

20. The method according to claim 19 wherein the compound is combined with another lipid-lowering agent.

21. Process for preparing a compound of the formula (I) according to claim 11, comprising

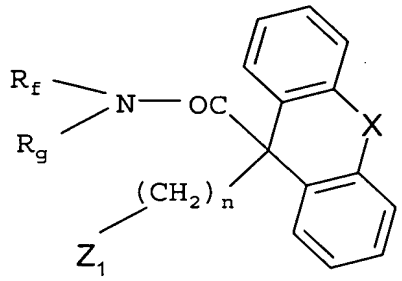
a) reacting under suitable conditions a compound of formula



, (II)

wherein

R_a, R_b and R_c are defined as in claim 11, with a compound of formula



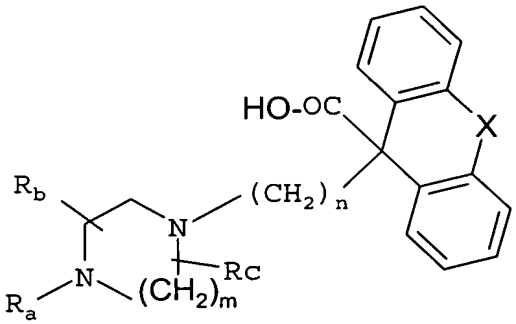
, (III)

wherein

n, R_f, R_g and the tricyclic system are defined as in claim 11 and

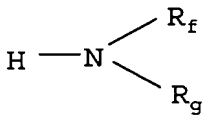
Z_1 denotes a nucleofugic leaving group, or

c) reacting under suitable conditions a compound of formula



, (IV)

with an amine of formula



, (V)

wherein

R_f and R_g are defined as in claim 11, or with the reactive derivatives thereof and

c) optionally reducing under suitable conditions the product of a) or b) which contains a nitro group if desired into a corresponding amino compound and/or

d) if R_f denotes a hydrogen atom alkylating under suitable conditions the product into a corresponding compound wherein R_f denotes a phenyl-C_{1-3}-alkyl group, and/or

e) cleaving under suitable conditions any protecting group using to protect reactive groups during the reactions and/or

resolving the product any of the product above into its stereoisomers and/or

converting any of the products above into the physiologically acceptable salts thereof.